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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,116	08/01/2003	Ying Ma	MA1	3487

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EXAMINER

GUIDOTTI, LAURA COLE

ART UNIT PAPER NUMBER

1744

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/632,116

Applicant(s)

MA, YING

Examiner

Laura C. Guidotti

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04012004, 08012003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, drawn to a mascara brush, classified in class 132, subclass 218.
  - II. Claim 13, drawn to a method for manufacturing a mascara brush, classified in class 300, subclass 21.
  - III. Claim 14, drawn to the use of a mascara reservoir, classified in class 132, subclass 218.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, and III are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(i)).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I or III, restriction for examination purposes as indicated is proper.

Art Unit: 1744

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Examiner Doan and Sheridan Neimark on 05 October 2005 and during a telephone conversation with Examiner Guidotti and Sheridan Neimark on 11 January 2006 a provisional election was made with traverse to prosecute the invention of group II, a method for manufacturing a mascara brush, claim 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 and 14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "1" (the mascara brush, specification Page 5 Line 22). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vasas, USPN 6,237,609 in view of Leone, USPN 5,611,361 and Merion, USPN 2,917,956.

Vasas discloses the claimed invention including a method for manufacturing a mascara brush comprising a plurality of bristles (50) held between two intertwined wire sections forming a core (40), the core comprising a curved core section (see Figures 1 and 3), including the steps of manufacturing a raw brush having a straight core and bending the brush (including the core) into an arcuate shape (Column 4 Lines 20-25). Vasas does not disclose that the raw brush has at least two straight cores or that the cores were bent by inserting them into a bending tool having a plunger and counter-plunger and then taking the cores from the bending tool.

Leone discloses a mascara application system that includes a brush having a plurality of bristles held between two intertwined wire sections forming a first core and a plurality of bristles held between two intertwined wire sections that form a second core, wherein the cores extend from a common handle section (see Figure 7). Leone

Art Unit: 1744

teaches that there are two brushes including two cores in order to enable uniform application of mascara to upper and lower eyelashes (Column 3 Lines 31-33).

Merion teaches a bending tool that is used to bend wire and is capable of bending intertwined wire cores (Column 1 Lines 25-27), the bending tool has a convex bending "plunger" (Figure 4, 44; Column 2 Lines 55-64; "plunger" is defined as "mechanical device that has a plunging or thrusting motion" according to *WordNet* ® 2.0, © 2003 Princeton University, and the bending block "44" of Merion is considered to act as a plunger) and a concave "counter-plunger" (26) that are "essentially" complementary thereto (Figure 4), wherein the device of Merion manufactures wire or sheet metal by inserting wire or metal into the bending tool, bending the wire or metal, and then removing the wire or metal from the bending tool (Column 1 Lines 25-27, Column 2 Lines 21-64).

It would have been obvious for one of ordinary skill in the art to modify the manufacturing steps of Vasas to include a raw brush having two straight cores extending from a common handle, as Leone teaches, so that the finished mascara brush product will enable uniform application of mascara, and it would have been obvious for one of ordinary skill in the art to bend the wire cores of Vasas and Leone using a bending tool having convex and concave plungers and undergoing manufacturing bending steps, as Merion teaches, in order to effectively bend a wire metal device requiring an arcuate bend.

### **Conclusion**

Art Unit: 1744

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2005/0150510 to Chant also discloses a mascara brush having two straight cores, however is published after the filing date of the present invention.

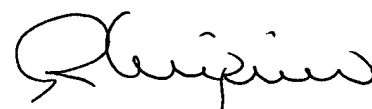
USPN 4,056,863 to Gunjian and USPN 3,230,563 to Swanson are other examples of brushes having two dual-wire intertwined cores.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Guidotti whose telephone number is (571) 272-1272. The examiner can normally be reached on Monday-Thursday, 7:30am - 5pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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